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EXAMINER	
TANG, KAREN C	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE HENRY AHRENS JR., and CHETAN MEHTA

Appeal 2008-1436
Application 09/978,352
Technology Center 2400

Decided: November 17, 2008

Before JAMES D. THOMAS, LANCE LEONARD BARRY,
and JEAN R. HOMERE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 4, 6 through 13, 15 through 22, and 24 through 27, Appellants having canceled claims 5, 14, and 23. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

As best representative of the disclosed invention and as best depicted in figure 3 of the application as filed, representative independent claim 1 is reproduced below:

1. A method in a data processing system including a logically partitioned computer system and a hardware management console, said hardware management console being a stand-alone system separate from said logically partitioned computer system, a service application being executable by said hardware management console for managing service of and placing service calls for said logically partitioned computer system, said method comprising the steps of:

including a service partition and a service processor within said logically partitioned computer system;

monitoring, by said service processor, a presence of said service application executing on said hardware management console; and

in response to an absence of said service application, reporting utilizing said service partition, said absence of said service application to a system administrator of said service partition.

The following references are relied on by the Examiner:

Moiin	US 6,550,017 B1	Apr. 15, 2003 (filing date June 29, 1999)
Quinlan	US 2002/0021671	Feb. 21, 2002 (filing date Aug. 8, 2001)

Applicant Admitted Prior Art, "Description of Related Art" within the Specification.

All claims on appeal stand rejected under 35 U.S.C. § 103. As evidence of obviousness as to claims 1 through 4, 6, 10 through 13, 15, 19 through 22, and 24, the Examiner relies upon Appellants' admitted prior art in view of Moiin. This combination of references is utilized further in view

of Quinlan as to claims 7 through 9, 16 through 18, and 25 through 27. The Examiner's apparent reliance upon Appellants' admitted prior art is with respect to the "Description of Related Art" at Specification page 1, line 21 through Specification page 3, line 27.

Rather than repeat verbatim the positions of the Appellants and the Examiner, we refer to the Brief and Reply Brief for Appellants' positions, and to the Answer for the Examiner's positions.

OPINION

For the reasons generally set forth by Appellants in the Brief and Reply Brief, we agree with their views that the subject matter of representative independent claim 1, which is representative of corresponding subject matter in independent claims 10 and 19, would not have been obvious to the artisan within the first stated rejection of Appellants' admitted prior art in view of Moiin.

Appellants' contribution to the art in disclosed figure 3 utilizes a service application 284 within a hardware management console 280, both of which has been recognized and relied upon by the Examiner as part of the prior art in the above-noted admitted prior art. A subtle feature of the subject matter recited in representative independent claim 1 on appeal pertains to monitoring the "presence" of this service application and the determination that it may be "absent." As disclosed in the abstract of the disclosed invention at page 30 of the Specification as filled, the assessment of the admitted prior art at Specification pages 2 and 3, the discussion at Specification page 6, line 16 through page 7, line 31, the showing in figure 4

and the corresponding discussion at Specification page 17, line 24 through page 19, line 2, this presence or absence is determined with respect to the actual physical presence or absence of the claimed service application.

Representative independent claim 1 reflects in part the physical relationship of this named element in this claim to those shown in Specification figure 3. Although Appellants do not present an argument to us that the Appellants' admitted prior art and Moiin are not properly combinable within 35 U.S.C. § 103, from our perspective, we find that it would have been difficult for an artisan to understand and follow the Examiner's reasoning and correlation of the disclosed elements in Moiin, principally those in figures 1 and 3, to those of the admitted prior and in turn to the subject matter of the claims on appeal.

Essentially, we tend to agree with the Appellants' positions in the Brief and Reply Brief that the essential correlations and functionality required by the different elements recited in representative independent claim 1 on appeal does not flow from the combination of teachings of Moiin and the admitted prior art. In essence, in their broadest perspective, Appellants' lengthy remarks in the Brief and Reply Brief point to the Examiner's speculation of the associations with no clear, unambiguous correlation of the elements and their functionality in Moiin to those of the claims on appeal. As best contested in the Reply Brief, the Examiner's mapping of elements in Moiin and their function to the claimed function and element does not effectively line up with the admitted prior art and with the subject matter of the claims on appeal. The Examiner's reasoning is therefore strained. As Appellants' positions appear to repeat, what the

Examiner relies upon as the claimed service processor does not functionally appear to actually monitor the presence of a service application within the hardware management console of the admitted prior art, and there appears to be no clear leading or teaching from the Examiner to do so.

If, as implied from the subject matter of representative independent claim 1 on appeal that no presence of the service application is detected by the service processor, an absence is therefore detected. Upon determining this absence, as required by representative independent claim 1 on appeal, it is the service partition which is utilized to convey to a system administrator the absence of this service application. We are therefore led, inescapably, to the conclusion that the artisan would not have considered the subject matter of representative independent claim 1 on appeal obvious within 35 U.S.C. § 103 in light of the Appellants' admitted prior art and Moiin's teachings. Since corresponding features are recited in independent claims 10 and 19 on appeal, this conclusion applies equally well to them as well as to all the respective dependent claims on appeal, including those within the second stated rejection that further relies upon Quinlan.

NEW GROUND OF REJECTION WITHIN 37 C.F.R. § 41.50(B)

Within the provisions provided to us by 37 C.F.R. § 41.50(b), we reject the subject matter of independent claim 19 and its respective dependent claims 20 through 22 and 24 through 27 as being directed to nonstatutory subject matter within 35 U.S.C. § 101. Since there is no directly taught computer program "product" disclosed, we construe this computer program product of independent claim 19 as being a computer

readable medium within the teachings at Specification page 19, lines 3 through 21. Since the product is not stated to be a tangible item in claim 19 the subject matter of claim 19 reads directly upon an intangible signal embodiment as a type of transmission media embodying the mediums listed in the noted paragraph. The three directly recited "instruction means" in the body of claim 19 appears to directly relate to intangible signals discussed in this paragraph. Note the reasoning in *In re Nuijten* 500 F.3d 1346, 1359 (Fed. Cir. 2007). This reasoning follows through with the noted dependent claims.

In summary, we have reversed the two stated rejections of the claims on appeal within 35 U.S.C. § 103. On the other hand, we have instituted a new ground of rejection based upon 35 U.S.C. § 101 of claims 19 through 22 and 24 through 27.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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